

REMARKS

Applicant has amended claims 30, 36, 38 and 44. Claims 30-46 are pending in this application. In the Official Action, the Examiner has rejected claims 30-46 under 35 U.S.C. § 103(a) as unpatentable over Wrigley in view of Freeman and Tomkinson. Applicant has made some minor grammatical clarifications to the claims as noted (such as changing "the" to "said" for consistency, adding "of said collar" for clarity and making "surface" plural) and has now specified that the weight to be supported by the claimed safety anchor is at least the full weight of an adult human.

Based on amendments and the remarks below, applicant believes that the rejections of the claims as set forth in the office action have been overcome. Thus, favorable reconsideration and allowance are earnestly solicited. If, however, for any reason the Examiner does not believe that such action can be taken at this time, he is respectfully requested to telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections.

I. The Claimed Invention

Applicant's invention provides a unique safety anchor for providing an attachment point to a wall of a building, such as a roof, for attachment of a tether to support at least the full weight of an adult human. Applicant's invention solves a problem that emergency personnel such as firefighters face in trying to save human life and property. Problems with prior safety fall restraints or safety anchors are described in the application at paragraphs 4 and 5. For example, prior safety anchors required access to the interior of the building and the drilling of a hole through the roof into a structural member such as a rafter or the need to locate a rafter from the

exterior of the roof. These prior devices can create safety hazards and unnecessary risks since timing is critical in an emergency situation where, for example, a firefighter stationed on the roof and fighting a fire needs to immediately "anchor" to the roof of the building to prevent a fall off the roof. Obviously, the longer it takes to set up the safety anchor and tether, the less time remains to fight the fire. This problem was recognized and solved by the applicant with the present invention of a quick install safety anchor, that pierces entirely through the interior and exterior of the wall of the building, with no pre-drilling required, and which will support at least the full weight of an adult human.

With this background in mind, the present invention as claimed provides a structurally unique safety anchor that is not rendered obvious by the combination of prior art references applied in the office action for the reasons discussed below.

II. The Cited References

A. Wrigley

Wrigley, not previously cited, discloses a fastening device for securing fixtures to walls or ceilings. The device includes a partially threaded bolt A terminating at an insertion end with an eye-head a. A weighted bar B, with one end heavier than the other, is pivotally attached to the eye-head via a rivet b. The device is inserted into pre-drilled or pre-punched holes in the wall. The types of wall materials described in Wrigley are a ceiling or wall built of fireproof material such as hollow tiling or a wall lined with terra cotta or marble slabs. (Wrigley, col. 1, lines 12-15; col. 2, lines 56-57, 78-79.) To insert the fastening device, the weighted bar is positioned parallel to the bolt, with one end of the bar extending past the

eye-head end. Once inserted into the hole, the bar clears the hole and the heavier end of the bar by its own weight will swing and assume a T position against the rear of the wall. The other end of the bolt of Wrigley can be provided with a ring or loop or other casting to engage a pipe (such as a gas pipe) or other fixture. Alternatively, a nut is used to secure the fixture to the wall and any surplus length of the bolt extending beyond the fixture can be cut off by means of a saw or file.

B. Freeman

Freeman discloses a connector that fastens sheet-metal panels to fiber-board ducts by passing through *pre-bored holes* in the metal panel and punching its own hole in the fiber-board. (Abstract.) Freeman's connector comprises a plastic rod 13 having barb-like grooves 31 for retaining a press-on nut 33. The end 37 of the plastic rod is broken off after installation and is thus not intended to be weight bearing, let alone support significant weight such as the full weight of an adult human. In one embodiment, the plastic rod has a hole-punching plastic head 55 and a toggle-bolt-type two-arm expandable anchoring member. (Figs. 11 and 12.) The hole punching plastic head is for piercing fiber-board or other soft-material panels, and any hard material panel is pre-bored. As such, particularly in light of the plastic head's attachment to the plastic rod, the piercing head of Freeman is not adapted to pierce through a non-predrilled roof or wall of a building.

C. Tomkinson

Tomkinson discloses a ground anchor with a relatively complicated wing-spreading mechanism for piercing the pointed ends of wings 20 and 21 into the adjacent walls of a pre-provided hole (see Fig. 1). Tomkinson includes a collar to stop

or limit the upward bias of the crosshead 41. The collar of Tomkinson is not meant to help anchor the ground anchor by sandwiching the wall with the wings 20 and 21, and in fact, collar 61 of Tomkinson is disposed within the wall.

III. Why It Would Have Not Been Obvious To Modify Wrigley With Elements From Freeman

To establish a prima facie case of obviousness, there must be shown "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 837 F.2d 1071 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (emphasis added). No such teaching is present here that would motivate one to combine Wrigley and Freeman as proposed by the Examiner.

First, the mere fact that Freeman discloses a piercing end is insufficient to provide a teaching or motivation to combine. Because Freeman has a different type of fastening methodology (piercing tip and toggle bolt) than Wrigley does not mean that one skilled in the art would have employed the methodology of Freeman with Wrigley. *See Hartness Int'l, Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100, 1108, 2 U.S.P.Q.2d 1826, 1832 (Fed. Cir. 1987) ("[T]he inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole")

In *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 57 U.S.P.Q.2d 1161 (Fed. Cir. 2000) the district court erroneously concluded that it would have been obvious to combine screw anchors and metal brackets, because the need for a bracket "was apparent." As noted by the Federal Circuit, because there is

"a general rule that combination claims can consist of combinations of old elements as well as new elements," ... "[t]he notion ... that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, § 103." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1575, 1 U.S.P.Q.2d 1593, 1603 (Fed. Cir. 1987); *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 U.S.P.Q.2d 1294, 1297 (Fed. Cir. 1997) ("It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements."). The test is not whether one device can be an appropriate substitute for another. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383, 231 U.S.P.Q. 81, 93 (Fed. Cir. 1986)

Ruiz, 57 U.S.P.Q.2d at 1167.

Second, the improvement disclosed in Wrigley is the use of a weighted bar B with one end heavier than the other in order to allow for gravity to rotate the bar into a vertical position once the device is inserted into a wall *already provided with a bore*. Given that a hole already exists in the wall, there is no reason or motivation why one would add a wall-piercing element to Wrigley, notwithstanding that Freeman happened to disclose a plastic piercing head.

Thus, Wrigley teaches away from using the end of the fastener to pierce through the surface based on the nature of the wall materials disclosed in Wrigley as well as the fact there is a weighted bar at the end to be inserted into the hole in the wall. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant . . . [or] if it suggests that the line

of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994).

Third, any teaching of Freeman is to provide a plastic piercing end when it is necessary to pierce through a softer material that is adjacent a harder, *pre-bored* material. Thus, since the material in Wrigley is pre-bored, one would not be motivated by Freeman to modify Wrigley to provide a piercing function. The problem of Freeman - how to tunnel through a softer material in a surface below a harder pre-bored surface - is not relevant to Wrigley nor to the present invention, which must pierce through a totally unpierced roof or wall. Thus, Freeman's "solution" to its problem provides no teaching or motivation for one to modify Wrigley.

Fourth, There would be no motivation for one to look to Freeman in modifying Wrigley. Namely, Freeman is not a fastener that is intended to include a weight-bearing end as in Wrigley. In other words, one looking to improve or modify Wrigley would not be motivated by a reference like Freeman, which is for fastening an outer sheet metal skin to soft fiber-board and not for providing any sort of attachment end for further supporting significant weight, such as the full weight of an adult human who would be anchored to the attachment end by a safety tether. Freeman is for fastening pre-bored sheet metal panels to soft-material fiber-board ducts with a plastic shaft soft enough and intended to be snapped off (see Fig. 3).

Further, the hole-punching head disclosed Freeman is made of plastic and molded or attached to the plastic axial rod. The head obviously would have insufficient strength to pierce

through a non-predrilled building wall, especially since it is not even designed to punch through the outer sheet metal panel. Further, no significant load could be attached to the end of Freeman because doing so would stress and break the breakable shaft and possibly the plastic piercing head. Thus, one of ordinary skill in the art would not be motivated to look to Freeman, which is not a weight bearing type of fastener, in modifying the weight bearing, fixture hanging device of Wrigley.

Fifth, the Examiner's recited motivation to modify Wrigley is not found in the references nor suggested by general knowledge. In particular, as to the piercing end, the Examiner states that "it would have been obvious ... to modify Wrigley to show the piercing end ... inwardly tapering to a sharp piercing point to facilitate the piercing of the wall piercing end through the ... wall ... because having [such] a piercing end ... *would enable the easy piercing* ... as taught by Freeman" (Office Action at 3-4 (emphasis added).) "Easy piercing," however, is not something that one would even be motivated to add to Wrigley. Wrigley does not need easy piercing since the wall is already pierced. The problem of Wrigley is how to secure the bolt into a pre-drilled wall hole and its solution is a weighted bar. Adding an easy piercing element to Wrigley is merely taking an element that exists in the prior art and adding it because it is there. See *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) ("It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated

disclosures in the prior art to deprecate the claimed invention.").

Sixth, even assuming for the sake of argument that one would be motivated to modify Wrigley with selected elements from Freeman (which applicant disputes is the case), it is unclear how one would modify Wrigley to include a wall-piercing end. The Examiner provides no details of how one would make the modification and applicant maintains there is no easy or readily apparent modification. This further supports why there is no motivation to combine.

For instance, modifying the weighted bar of Wrigley to include a sharp piercing end would not be practical since the end pivots about the eye-head and would not be stable for piercing into a wall (see Fig. 1 showing angular rotation of the weighted bar that would occur). A possible modification might be to relocate the weighted bar away from the end of the bolt so that a piercing end could be attached. In doing so, however, one would need to eliminate the eye-head portion of Wrigley and modify the bolt to provide for another type of attachment of the weighted bar thereto. Another possibility to modify Wrigley with elements from Freeman would be to completely eliminate the core patentable concept and teaching of Wrigley -- the end-mounted and pivoting weighted bar. One would also need to eliminate the eye-head at the end of Wrigley and completely replace this element with some type of piercing end and further design the shaft to accept the two arm spring biased member of Freeman. The fact that a complete overhaul of Wrigley would be needed supports a finding that it would not have been obvious to so drastically modify Wrigley and go against its teaching of using a weighted bar pivotally mounted at the end of the bolt.

Moreover, even if the references could somehow be combined or modified, that fact alone is insufficient to establish a *prima facie* case of obviousness. See M.P.E.P. § 214.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references). Here, the fact that Wrigley could be completely redesigned to remove its weighted bar and end of shank eye-head and replace it with a piercing head and a two arm anchoring member is insufficient to establish a *prima facie* case of obviousness.

Still further, the fact that the claimed invention might be within the capabilities of one of ordinary skill in the art is also insufficient by itself to establish a *prima facie* case of obviousness. See M.P.E.P. § 2143.01. Thus, proposed modifications of the prior art to meet the claimed invention, for the reason that it would have been well within the ordinary skill of the art to make the modifications because the references teach that all aspects of the claimed invention were individually known in the art, are not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. See *Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1301 (Bd. Pat. App. & Inter. 1993). Again, because one might be able to find individual aspects of the claimed invention in both *Wrigley* and *Freeman* is not enough to support their proposed combination, especially where no motivation to combine is present.

Seventh, Wrigley discloses that the wall into which the device is inserted already includes a bore. The type of material described in Wrigley is tile or a wall lined with terra cotta or marble slabs (col. 1, lines 14-15; col. 2, lines 56-57). Clearly, the type of material into which the device of Wrigley will be inserted is not the type that can or should be readily pierced with the fastening bolt itself. For tile or terra cotta, piercing with the end of the fastener could likely damage or mar the surface making it unsuitable for hanging a fixture thereto. Trying to drive the fastener in hard surfaces such as marble would also be extremely difficult, resulting in likely damage to the fastener from the needed force or to the marble, which could crack. Freeman likewise would want to avoid damaging the sheet metal and thus uses and teaches pre-bored holes through which the fastener can pass without piercing the outer surface that could cause damage thereto.

Thus, one of ordinary skill in the art would not be motivated to provide Wrigley with a piercing end since damage could result to the wall or the fastener. Clearly, unlike the present invention, Wrigley is not intended for use to puncture and damage walls in emergency situations, and neither is Freeman. Rather, the present invention addresses a problem not confronted by Wrigley or Freeman; namely, how to drive a safety anchor into the wall of a building as fast as possible without a moment's thought to damaging, cracking or marring the wall upon insertion of the anchor. Thus, the device is constructed to ensure that it will penetrate and anchor safely completely through the wall or roof of a building to support the weight of the firefighter. "The problem confronted by the inventor must be considered in determining whether it would have been obvious to combine references in order to solve that problem."

Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679, 7 U.S.P.Q.2d 1315 (Fed. Cir. 1988).

Eighth, Wrigley teaches away from using two arms for anchoring to the wall. Namely, the fastening method of Wrigley is simple and uses one "arm" or bar. It would complicate and add expense to Wrigley if one bar now becomes two bars and a spring is added to allow the bars to spring open. Thus, one of ordinary skill in the art would not be motivated to increase complexity and cost of Wrigley by using a spring biased toggle bolt with two arms as disclosed in Freeman instead of the single bar which functions as both arms once in the open, perpendicular position.

Ninth, any perceived "simplicity" of the claimed invention, which does, like most other patented inventions, use elements that can be found separately in various prior art references, should not affect whether it would have been obvious. See, e.g., *Henkel Corp. v. Coral Inc.*, 754 F. Supp. 1280, 1315, 21 U.S.P.Q.2d 1081, 1106 (N.D. Ill. 1990), *aff'd*, 945 F.2d 416 (Fed. Cir. 1991) (unpublished) ("The apparent simplicity of a claimed invention does not render it more easily invalidated. ... [T]o equate simplicity with obviousness is an erroneous concept."); *Dolly Inc. v. Spalding & Evenflo Companies Inc.*, 18 U.S.P.Q.2d 1737, 1751 (S.D. Ohio 1991) ("The relative simplicity of a device does not render the claimed invention obvious."); *State Industries, Inc. v. Mor-Flo Industries, Inc.*, 639 F. Supp. 937, 945, 231 U.S.P.Q. 242, 247 (E.D. Tenn. 1986), *aff'd*, 818 F.2d 875 (Fed. Cir. 1987) ("The invention here in dispute is simple and there is an inclination to find such simple things to be obvious. However, if the invention were so obvious why hadn't anyone come up with it ...?").

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Accordingly, for the foregoing reasons, it is respectfully submitted that the rejection of the claims based on obviousness be withdrawn.

Further, as to dependent claims 36 and 44, no combination of the cited references, even if properly combinable, would produce a safety anchor with the first and second members each including ends that meet to form the piercing end when the members are in the closed position. Thus, the obviousness rejection of these claims should also be withdrawn for this additional reason.

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As it is believed that all of the rejections set forth in the office action have been fully met, favorable reconsideration and allowance are earnestly solicited. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections that he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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